

09/361,478 filed 07/26/1999

Parce et al.

Reply to Office Action of October 17, 2005

REMARKS/ARGUMENTS

Claims 1 and 3-15 are pending in the application. In the Final Office Action mailed October 1, 2004, all of the pending claims were rejected. In this response to the Final Office Action, claims 12 and 13 have been cancelled.

I. Claim Rejections under 35 U.S.C. § 102(e)

Claims 12 and 13 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Publication 2004/0063162 ("Dunlay"). Claims 12 and 13 have been cancelled, rendering the rejection of those claims moot.

II. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 3-11, 14, and 15 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Dunlay and U.S. Patent No. 6,500,323 ("Chow"). The terms of 35 U.S.C. § 103(c) disqualify Chow as being prior art under 35 U.S.C. § 103(a), so the obviousness rejection of claims 1, 3-11, 15, and 15 cannot be sustained. See M.P.E.P. § 706.02(I)(1). Note that even though the filing date of the pending application is before November 29, 1999, the terms of 35 U.S.C. § 103(c) still apply because this application was pending as of December 10, 2004. M.P.E.P. § 706.02(I)(1). The other requirements of 35 U.S.C. § 103(c) are satisfied because Chow only qualifies as prior art under 35 U.S.C. § 102(e), and the subject matter of Chow and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. MPEP §§ 706.02(I)(1), 706.02(I)(2). The "EVIDENCE REQUIRED TO ESTABLISH COMMON OWNERSHIP" section of MPEP § 706.02(I)(2) provides a statement that, when made by the representative of an applicant, provides sufficient evidence to establish common ownership of, or an obligation for assignment to, the same persons or organizations. That statement is provided in the next separately labeled section.

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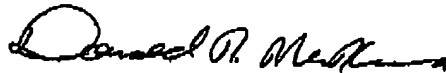
III. STATEMENT OF COMMON OWNERSHIP

Pending Application Serial No. 09/361,478 and U.S. Patent No. 6,500,323 ("Chow") were, at the time the invention of Pending Application Serial No. 09/361,478 was made, both owned by Caliper Technologies Corp. After the filing of Pending Application Serial No. 09/361,478, Caliper Technologies Corp. changed its name to Caliper Life Sciences, Inc. Pending Application Serial No. 09/361,478 and Chow are still all owned by the same entity, which is now called Caliper Life Sciences, Inc.

CONCLUSION

For the foregoing reasons, Applicants believe all the pending claims (claims 1, 3-11, 15, and 15) are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: 